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09/892,747	06/28/2001	Tatsuo Nomura	1035-332	3643

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EXAMINER
BARQADLE, YASIN M

ART UNIT	PAPER NUMBER
2153	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/892,747	NOMURA ET AL.
	Examiner	**Art Unit**	
	Yasin M. Barqadle	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>30 April 2007</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-33* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-33* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

Response to Amendment

1.   The amendment filed on April 30, 2007 has been fully considered but are not deemed persuasive.

- Claims 1-33 are presented for examination.

- New claim 33 has been added.

Response to Arguments

2.   Applicant argues, "Anyone who has installed software on a computer is aware that simply completing the installation process does not ensure that the program will properly operate when executed. Consequently, Applicants respectfully submit that the portion of Nakagawa et al. cited in the office action does not disclose or suggest the confirming of proper program operation as set forth in claim 1."(Page 11, last paragraph). Examiner notes that Nakagawa et al teaches in the sentence just above the cited portion " since, the updated software can also be installed, an unskilled user can readily utilize the object software obtained" (col. 28, lines 39-41). In this case confirming the successful installation of the software and notifying the vendor server implies proper operation of the software. Otherwise software failures are reported to the vendor for further debugging and correction (col. 57, lines 31-53). "In response to the report, the vendor removes the fault and corrects the software library. Then, the user can immediately use and execute the corrected software" (col. 35, lines 12-22).

Applicant also argues "payment for the program is requested based on confirming the operability of a program, not on a user's

satisfaction with the program as in Nakagawa et al. In claim 1, once it is confirmed that the program is operable, payment is requested, regardless of the user's satisfaction with the program."(Page 12, second paragraph). Examiner notes that user satisfaction implies the proper operation of the software. Therefore, demanding payment after the user indicates his satisfaction (of the proper operation) of the software meets the claimed limitation of the claim 1 as argued by the Applicant.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oki (U.S. Patent Number **5,859,969**, hereinafter "Oki") in view of Nakagawa et al USPN. (5835911), hereinafter "Nakagawa"). Oki discloses a remote installation system and method. Oki shows:

In referring to claim 1 and 8,

- Transmitting an operating environment of the user system from the user system via the network to the server before supplying the program:

"The circumstance information informing unit obtains circumstance information relating to software operation circumstances in the terminal equipment and informs the distributing center of them. " (Oki, col. 2. lines 33-36 and col. 8, lines 36-65)

- Judging whether the program is operable or not in the operating environment, and transmitting a result of the judgment from the server via the network to the user system: "The circumstance checking unit compares the circumstance information received from the circumstance information informing unit with that of the target software to check whether or not they are compatible, and informs the installing unit of the check result thus obtained. The installing unit decides whether or not the target software is to be distributed and if so, it determines a software distributing method, in response to the check result." (Oki, col. 2, lines 37-44).

- Executing the program on the user system after the program is supplied from the server and installed on the user system: The purpose of the system of Oki is to download new software to be executed on the client. Executing the softwar0e is inherently implied in the system of Oki

Although Oki shows substantial features of the claimed invention, he does not explicitly show receiving confirmation at a server of proper operation of the program.
Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Oki, as evidenced by Nakagawa USPN. (5835911).
In analogous art, Nakagawa disclose "If the third process unit CP receives a message from vendors V1, V2, . . . and stores or installs in the user computer 11 new software, newly served

software, or updated software received from vendor Vk, then the third process unit CP monitors the result of these processes and sends to the fourth process unit SP of vendors V1, V2, . . . over the network 12 a process result confirmation message informing whether the process has terminated normally or abnormally. As a result, the vendor can recognize a process result in the user computer 11" (col. 28, lines 38-51).

Giving the teaching of Nakagawa, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Oki by employing the system of Nakagawa because it enables the provider/vendor of the software to recognize the process result in the user computer so that the vendor can demand payment for the software if it working properly or fix the bugs in the software if is not working properly.

Nakagawa further teaches requesting payment for a program "Every user is sent the object software as shareware on the response of the new purchase request, and the above described fund is demanded of the user to pay after the user's satisfaction of the software." (User satisfaction must be received before demanding funds by the vendor server col. 59, lines 35-50)

In referring to claim 2,

- Displaying the result of the judgment as to whether the program is operable or not in the operating environment of the user system:
  "The installing menu display unit displays plural methods of installing the target software." (Oki, col. 3, lines 45-46)

In referring to claim 3 and 9,

- Transmitting an order for the program from the user system via the network to the server when the program is judged to be operable:

    Oki, Fig. 4 shows selecting a program S12, checking if the program is operable at S14, Fig. 5 shows transmitting the selected program at S18

In referring to claim 4 and 10,

- Generating a program list made up of programs which can be supplied from the server, transmitting the program list from the server via the network to the user system; selecting a program from the program list:

    "When the user inquires of the host computer 21 for the keyword lists through the terminal 23, the host computer 21 transmits' the first and second key tables 32 and 33 successively and displays keywords included in them on the display 24 of his terminal 23. The user selects the displayed keywords which corresponds to the target software and informs the host computer 21 of his selection." (Oki, col. 5, lines 14-20)

In referring to claim 5,

- Generating by the server a program list made up of programs which can be operated in the operating environment of the user system; transmitting the program list from the server via the network to the user system; selecting a program from the program list: *Oki, col. 5, lines 14-20* (see full quote above)

In referring to claim 6 and 11,

- Storing the result of judgment as data of the user system in the server when the program is judged to be inoperable: Storing the result of a judgment made in a server is inherently implied in a server that conducts said judgment

In referring to claim 7,

- Expanding functions of the user system when a program supplied from the server via the network to the user system is installed:
  Expanding functions of a user system by installing a program is inherently implied in a system in which a program is installed in a user system

In referring to claim 12,
- Said user system includes operating environment judging means for judging an operating environment of the user system, and before having a program supplied, transmits the judged operating environment via the network to the server: Oki, col.2, lines 33-36 (see full quote above)

- Said server includes operation judging means for judging whether the program is operable or not in the received operating environment, and transmits a result of judgment as to whether the program is operable or not via the network to the user system: *Oki, col. 2, lines 37-44* (see full quote above)

- Said user system is operable to execute the program on the user system after the program is supplied from the server and installed on the user system to thereby confirm operation of the program:

The purpose of the system of Oki is to download new software to be executed on the client. Executing the software is inherently implied in the system of Oki

As to receiving confirmation information and requesting payment for a program after its proper operation see the rejection above in claim 1 and 8.

In referring to claim 13,

- Operation input means to be operated by a user, said user system is activated in response to operation on the operation input means:

  "When the user inquires of the host computer 21 for the keyword lists through the terminal 23, the host computer 21 transmits' the first and second key tables 32 and 33 successively and displays keywords included in them on the display 24 of his terminal 23. The user selects the displayed keywords which corresponds to the target software and informs the host computer 21 of his selection." (Oki, col. 5, lines 14-20)

- Display means for displaying data; displaying the result of judgment given by the operation judging means of the server on the display means:

  Oki, *col. 3, lines 45-46* (see full quote above)

- The user system transmits the operating environment judged by the operation environment judging means via the network to the server:

  Oki, Fig. 3 shows judging the operation environment at steps S1 and S2, and then _ transmitting them at step S3

In referring to claim 14,

- Said user system orders the program to the server when the result of judgment received from the server indicates that the program is operable:

  Oki, Fig. 4 shows the user orders the program after the judgment (circumstance check)

In referring to claim 15,

- Said server further includes storing means for storing data of the user system: Receiving user data and running a script on said user data (Oki, Fig.4, S14 and 40) inherently implies a storing means to store said user data

In referring to claim 16,

- Said user system expands its functions when a program supplied via the network from the server is installed.

Expanding functions of a user system by installing a program is inherently implied in a system in which a program is installed in a user system.

In referring to claim 17,

- Said user system is any of a personal computer, a portable terminal, and a complex digital image forming apparatus:

    Oki, Fig. 2 shows the user system is a portable terminal

In referring to claim 18,
- Said server further includes list generating means for generating a program list made up of programs which can be supplied to the user system, and transmits the program list via the network to the user system; said user system displays the program list on the display means, and selects a program from the program list according to operation on the operation input means:

    Oki, col. 5, lines 14-20 (see full quote above)

In referring to claim 19,

- Said server further includes list generating means for generating a program list made up of programs which are operable in the operating environment of the user system; transmits the program list via the network to the user system, and said user system displays the program list on the display means and selects a program from the program list according to operation on the operation input means:

Oki, Fig. 4 shows requesting a list from the server S10, generating a list at the server, receiving and displaying the list S12, and selecting a program from the list S12

In referring to claim 20,

- Said server stores the result of judgment by the operation judging means when the program is judged to be inoperable: Storing the result of a judgment made in a server is inherently implied in a server that conducts said judgment

In referring to claim 21-22, 25 and 29-32, Oki shows substantial features of the invention as discussed in claims 1 and 8 above. Oki further teaches:

- Operating environment judging means for judging an operating environment of the user system; user-side communication means for transmitting data to and receiving data from the server via the network:
  Oki, col. 2, lines 33-36 (see full quote above)

- Server-side communication means for transmitting data to and receiving data from the user system via the network; operation judging means for judging whether a program can be operated or not in the operating environment of the user system received via the server-side communication means:

Oki, col. 2, lines 37-44 and col. 8, lines 36-65 (see full
quote above)

- Said user system is operable to execute the program on the
  user system after the program is supplied from the server
  and installed on the user system to thereby confirm
  operation of the program: The purpose of the system of Oh
  is to download new software to be executed on the client.
  Executing the software is inherently implied in the system
  of Oki (See col. 8, lines 36-65)

Although Oki shows substantial features of the claimed
invention, he does not explicitly show transmitting a
notification of operation confirmation to a server.
Nonetheless, this feature is well known in the art and would
have been an obvious modification of the system disclosed by
Oki, as evidenced by Nakagawa USPN. (5835911).
In analogous art, Nakagawa disclose "If the third process unit
CP receives a message from vendors V1, V2, . . . and stores or
installs in the user computer 11 new software, newly served
software, or updated software received from vendor Vk, then
the third process unit CP monitors the result of these
processes and sends to the fourth process unit SP of vendors
V1, V2, . . . over the network 12 a process result
confirmation message informing whether the process has
terminated normally or abnormally."
Giving the teaching of Nakagawa, a person of ordinary skill in
the art would have readily recognized the desirability and the
advantage of modifying Oki by employing the system of Nakagawa
because it enables the provider/vendor of the software to
recognize the process result in the user computer so that the

vendor can demand payment for the software if it working properly or fix the bugs in the software if is not working properly.

As to receiving confirmation information and requesting payment for a program after its proper operation see the rejection above in claim 1 and 8.

In referring to claim 23,

- Transmitting by a user system an order for a program via a network to a server; Oki, Fig 3 shows selecting software at step S12

- Receiving the program in response to be order from the server via the network; Oki, Fig. 5 shows receiving the program at S17 in response to the selection
- Executing the program to thereby confirm proper operation thereof; (*Oki fig. 5 and* col. *2,* lines 37-44)

In referring to claim 24,
- User-side operation judging means for executing the received program, thereby confirming proper operation of the program; upon the user-side operation judging means executing the received program, (*Oki fig. 5 and Oki,* col. *2,* lines 37-44)

As per claims 23 and 34, although Oki shows substantial features of the claimed invention, he does not explicitly show transmitting a notification of operation confirmation to a server.

Although Oki shows substantial features of the claimed invention, he does not explicitly show transmitting a notification of operation confirmation to a server.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Oki, as evidenced by Nakagawa USPN. (5835911).

In analogous art, Nakagawa disclose "If the third process unit CP receives a message from vendors V1, V2, . . . and stores or installs in the user computer 11 new software, newly served software, or updated software received from vendor Vk, then the third process unit CP monitors the result of these processes and sends to the fourth process unit SP of vendors V1, V2, . . . over the network 12 a process result confirmation message informing whether the process has terminated normally or abnormally." (Col. 28, lines 39-41).

Giving the teaching of Nakagawa, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Oki by employing the system of Nakagawa because it enables the provider/vendor of the software to recognize the process result in the user computer so that the vendor can demand payment for the software if it working properly or fix the bugs in the software if is not working properly.

In referring to claims 26,

- A computer-readable recording medium having a program for executing the program receiving method of claim 1 recorded thereon:

  A computer-readable recording medium having a program for executing the program is inherently implied in the computer system of Oki

In referring to claim 27,

- A computer-readable recording medium having a program for executing the program receiving method of claim 23 recorded thereon:

  A computer-readable recording medium having a program for executing the program is inherently implied in the computer system of Oki.

4.   Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oki (U.S. Patent Number 5,859,969, hereinafter "Oki") in view of Nakagawa et al USPN. (5835911), hereinafter "Nakagawa") and further in view of Applicant's Admitted Prior Art (AAPA).

Regarding claim 33,

Although Oki and Nakagawa teach substantial features of the claimed invention as shown in claims 1,8, 25 and 29, they do not explicitly show image formation apparatus with expansion units attached.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Oki and Nakagawa as evidenced by Applicant's Admitted Prior Art (AAPA) "Also, Japanese Unexamined Patent Publication No. 68058/1989 (Tokukaisho 64-68058) (published date: Mar. 14, 1989), discloses a facsimile apparatus whose functions can be expanded. This facsimile apparatus obtains programs for operating the expanded functions via communication means, and carries out the programs. Thus, functions which were not provided in the facsimile apparatus when it was purchased can be operated." (Page 2, lines 1-6). Giving the teaching

of AAPA, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Oki and Nakagawa by employing the image forming apparatus of AAPA in order to ensure and to judge whether a vendor supplied program can be operated or not and to provide the most recent software drivers that would guarantee the proper operation of the apparatus.

Conclusion

5. **ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

The prior made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Barqadle whose telephone number is 571-272-3947. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone numbers for the

organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained form the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR system. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YB

Art Unit 2153

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